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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------|
| 10/691,375 | 10/22/2003 | Ralph Lance Carter | 03142-P0063B | 4954 |
| 7590 03/29/2004 Wesley W. Whitmyer, Jr. St. Onge Steward Johnston & Reens LLC 986 Bedford Street Stamford, CT 06905-5619 | | | EXAMINER SHAHER, RICKY D | |
| | | | ART UNIT 2872 | PAPER NUMBER |

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/691,375 | Applicant(s) CARTER, RALPH LANCE | |
| | Examiner Ricky D. Shafer | Art Unit 2872 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/22/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, the use of the language "a first pair...mirrors" or "a second pair...mirrors" lacks proper nexus with respect to claim 1, line 2.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Davy et al ('156).

Davy et al discloses an optical system comprising a pair of ellipsoidal mirrors [(13,15), (13,19) or (19,15)], wherein an output focus point [(14) or (20)] of one mirror corresponds with an input focus [(14) or (20)] of another mirror. Note figures 1 and 6-8 and the associated description thereof.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by McLeod et al ('649).

McLeod et al discloses an optical system comprising a pair of ellipsoidal mirrors (11, 12), wherein an output focus point (16) of one mirror corresponds with an input focus (16) of another mirror. Note figure 1 and the associated description thereof.

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5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Yakimovsky ('540).

Yakimovsky discloses an optical system comprising a pair of ellipsoidal mirrors (10,12), wherein an output focus point (20) of one mirror (12) corresponds with an input focus (20) of another mirror (10) and one of said mirrors (12) includes pivoting means (44). Note figures 3 and 6 and the associated description thereof.

6. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Shafik ('605).

Shafik discloses an optical system comprising a pair of ellipsoidal mirrors (Me1, Me2), wherein an output focus point (F2) of one mirror corresponds with an input focus (F2) of another mirror. Note figure 7 and the associated description thereof.

7. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hunter ('075).

Hunter discloses an optical system comprising a pair of ellipsoidal mirrors (11,12), wherein an output focus point (15) of one mirror corresponds with an input focus (15) of another mirror. Note Fig 1 and the associated description thereof.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yakimovsky ('540).

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Yakimovsky discloses all of the subject matter claimed, note the above explanation, except for each of said mirrors including pivotable means.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the other mirror (10) of Yakimovsky to include typical pivoting means as is commonly used and employed in the art in order to accommodate for different eye positions, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. Note *In re Stevens*, 101 USPQ 284 (CCPA 1954).

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,676,265. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application (10/691,375) discloses no additional invention or discovery other than what was already claimed and patented in U.S. Patent 6,676,265 or what would have been obvious to one of ordinary skill in the art at the time the invention was made.

U.S. Patent 6,676,265 discloses a variable magnification optical system comprising a first pair of ellipsoidal mirrors (30, 31) each having an axis and including a first input mirror (30) having an object focus point (34) and an image focus point (37); a first output mirror (31) having an object focus point (37) and an image focus point (36), wherein the first pair of ellipsoidal mirrors (30, 31) are positioned so that the image focus point (37) of the first input mirror (30) corresponds substantially with the object focus point (37) of the first output mirror (31); a second pair of ellipsoidal mirrors (32, 33) each having an axis and including a second input mirror (33) having an object focus point (36) and an image focus point (38), a second output mirror (32) having an object focus (38) point and an image focus point (35), wherein the second pair of ellipsoidal mirrors (32, 33) are positioned so that the image focus point (38) of the second input mirror (33) corresponds substantially with the object focus point (38) of the second output mirror

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(32), wherein the image focus point (36) of the first output mirror (31) is substantially the same as the object focus point of the second input mirror (33), means for adjusting the relative position between the first and second pairs of ellipsoidal mirrors (31 , 32, 33, 34) wherein the image focus point (36) of the first output mirror (31) is constrained to move along a predetermined path to achieve a change in magnification. Note figures 2 to 3a.

12. The disclosure is objected to because of the following informalities:

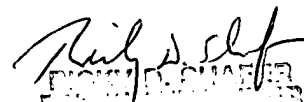
On page 1 of the specification, applicant states that the present application is a “divisional” application of U.S. Patent Application 09/942,019 which is inconsistent with applicant’s Utility Patent Application transmittal sheet which states that the present application is a “Continuation” of prior Patent Application 09/942,019. It is noted that the claims of the present application are similar to the claims of the parent application. Moreover, the current status of the prior application, once properly referenced, must be included.

Appropriate correction is required.

13. Any inquiry concerning this communication should be directed to Ricky D. Shafer at telephone number (571) 272-2320.

RDS

March 19, 2004


RICKY D. SHAFER
MAR 19 2004
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